APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/520,213	01/03/2005	Paul R. Simons	GB02 0107 US	5138

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EXAMINER
JIANG, YONG HANG

ART UNIT	PAPER NUMBER
2612	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/520,213	SIMONS ET AL.
	Examiner	Art Unit	
	Yong Hang Jiang	2612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>03 January 2005</u>.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-14</u> is/are pending in the application.

    4a) Of the above claim(s) <u>13 and 14</u> is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-12</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>03 January 2005</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date <u>1/3/2005</u>.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1.   Restriction to one of the following inventions is required under 35 U.S.C. 121:

    I.   Claims 1-12, drawn to an interactive system using tags to perform logic and data transfer operations, classified in class 340, subclass 10.51.

    II.   Claims 13-14, drawn to a method of promoting a product/service, comprising a promoter supplying profile tags having promotional data stored thereon for issue with an article, classified in class 705, subclass 65.

2.   Inventions group I and group II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination group II has separate utility such as promoting a product/service. See MPEP § 806.05(d).

The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to

provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

3.   The claims presented in the application were subject to a restriction; the claims were divided into two groups. Group I consisting claims 1-12, group II consisting claims 13-14. The applicant elected group I without traverse on 2/5/2008 during a telephone interview regarding the restriction. Affirmation of this election must be made by applicant in replying to this Office action.

Claims 13-14 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claims.

Priority

4.   Acknowledgment is made of applicant's claim for foreign priority based on an application filed in United Kingdom on 7/5/2002. It is noted, however, that applicant has not filed a certified copy of the 0215535.6 application as required by 35 U.S.C. 119(b).

Specification

5.   The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

(a) TITLE OF THE INVENTION.
(b) CROSS-REFERENCE TO RELATED APPLICATIONS.

(c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR
     DEVELOPMENT.
(d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
(e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A
     COMPACT DISC.
(f) BACKGROUND OF THE INVENTION.
     (1) Field of the Invention.
     (2) Description of Related Art including information disclosed under 37
     CFR 1.97 and 1.98.
(g) BRIEF SUMMARY OF THE INVENTION.
(h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
(i) DETAILED DESCRIPTION OF THE INVENTION.
(j) CLAIM OR CLAIMS (commencing on a separate sheet).
(k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
(l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A
     "Sequence Listing" is required on paper if the application discloses a
     nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if
     the required "Sequence Listing" is not submitted as an electronic
     document on compact disc).

Claim Objections

6.   Claims 7-9 are objected to because of the following informalities: on claim 7, the

phrase "an interactive tag having a store" on line 2 should be   --an interactive tag

having a **storage**--. Appropriate correction is required.

        Claims 8-9 depend on claim 7; therefore they suffer the same deficiency.

Claim Rejections - 35 USC § 112

7.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

    The specification shall conclude with one or more claims particularly pointing out and distinctly
    claiming the subject matter which the applicant regards as his invention.

8.   Claims 3-6 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

Claim 3 recites the limitation **"the said** profile information" in lines 3 and 4. There

is insufficient antecedent basis for this limitation in the claim.

Claims 4-6 depend on claim 3; therefore they suffer the same deficiency.

Claim Rejections - 35 USC § 102

9.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10.   Claims 1-2 and 10-11 are rejected under 35 U.S.C. 102(b) as being anticipated

by Tanaka (US 2002/0014529).

Regarding claim 1, Tanaka discloses a method of updating a user profile in an

interactive system (via method for communicating data between a first integrated circuit

and a second integrated circuit), comprising combining the information contained on an

identifier tag (via IC card 24A transferring data to IC card 24B) and at least one

interchangeable profile data tag (via IC card 24A). (See the Abstract and Col. 5, lines 14

to 35)

Regarding claim 2, Tanaka discloses the method is characterised in that the

information contained on the profile data tag is copied onto the identifier tag (via IC card

24A transferring data to IC card 24B). (See the Abstract and Col. 5, lines 14 to 35)

Regarding claim 10, Tanaka discloses an interactive tag (via IC card 24A)

comprising storage means (via memory 20A) having stored therein identity information

(in order to perform mutual-authentication with another IC card 24B, Col. 5, lines 26-35)

and profile information (via commands and sequences stored, Col. 5, lines 58-61 and

Col. 4, lines 11-15) which conditions a tag reader (IC card 24B). (See Col. 5, lines 14-

35)

Regarding claim 11, Tanaka discloses an interactive tag (IC card 24B) having

stored profile data which can be altered as desired (IC card 24B writing purchase record

data into memory 20B) in accordance with operating instructions carried by another tag

(IC card 24A instructing IC card 24B to write purchase record data) when read in

conjunction with the interactive tag. (See Col. 4, lines 11-19 and Col. 5, lines 14-35)

Claim Rejections - 35 USC § 103

11.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

12.   Claims 3-8 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Tanaka (US 2002/0014529) and further in view of Law et al. (US 6,859,801).

Regarding claim 3, Tanaka discloses a method of updating information in a

memory field of an interactive tag (via method for transferring data to IC card 24B, See

the Abstract), comprising accessing the memory field of the interactive tag (via checking

the contents of the memory 20B in the IC card 24B, Col. 5, lines 14-20), determining

from a second tag data to be used to update profile information (via IC card 24A

executing a sequence stored in the memory 20A, Col. 5, lines 29-34 and Col. 4, lines

11-15) and updating the profile information in accordance with an operating instruction

contained in the second tag (via the commands and sequences for transferring data,

Col. 4, lines 11-15). (See Col. 4, lines 11-19 and Col. 5, lines 14 to 35)

Tanaka further discloses the interactive tag (IC card 24B) and the second tag (IC

card 24A) have stored in their memories, operating instructions (via commands and

their sequences for transferring data). (See Col. 4, lines11-19)

But Tanaka fails to disclose the operating instruction is contained in a third tag.

Law teaches a system with a plurality of tags and a reader; Law discloses tags

are very limited in memory due to severe cost constraints in a tag system. (See the

Abstract, and Col. 1, lines 34-37)

From the teachings of Law, it would have been obvious to one of ordinary skill in

the art at the time the invention was made to modify the method disclosed by Tanaka to

include a third tag to store the operating instructions separately, thereby allowing the

use of cheaper tags with a smaller memory in order to reduce costs.

Regarding claim 4, the combination of Tanaka and Law discloses the tags are

read in conjunction (via IC cards 24A and 24B are loaded in an overlapped manner or

arranged side by side to a reader/writer 23). (See Tanaka, Col. 5, lines 14-35; and Col.

8, lines 48-51)

Regarding claim 5, the combination of Tanaka and Law discloses the tags are

submitted substantially simultaneously to a reading station (via IC cards 24A and 24B

are loaded in an overlapped manner or arranged side by side to a reader/writer 23).

(See Tanaka, Col. 5, lines 14-35; and Col. 8, lines 48-51)

Regarding claim 6, Tanaka discloses updating the profile information as the tags

are removed from the reading station (via IC tags starting operation as they are put

close to the reader/writer 23). (See Col. 7, lines 57-60)

Regarding claim 7, Tanaka discloses an interactive system (IC card system 21)

comprising tag reading means (via reader/writer 23), an interactive tag (IC card 24B)

having a storage (via memory 20B storing commands) for personal identifier information

and a programmable space (via memory 20B storing data transferred from IC card 24A)

for storing profile information, a second tag carrying profile data (via IC card 24A storing

purchase record about the entrance for an event, Col. 3, lines 53-67) and operating

instruction (via commands and sequences stored, See Col. 4, lines 11-15 and Col. 5,

lines 58-61), and means for reading the tags in conjunction (via reader/writer 23, see

Col. 5, lines 14-35 and Col. 8, lines 45-51) for using the profile data and the profile

information in accordance with the operating instruction.

But Tanaka fails to disclose the operating instruction is stored in a third tag.

Law teaches a system with a plurality of tags and a reader; Law discloses tags are very limited in memory due to severe cost constraints in a tag system. (See the Abstract, and Col. 1, lines 34-37)

From the teachings of Law, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system disclosed by Tanaka to include a third tag to store the operating instructions separately, thereby allowing the use of cheaper tags with a smaller memory in order to reduce costs.

Regarding claim 8, the combination of Tanaka and Law discloses the tag reading means has RF coupling means (via large loop antenna, Col. 8, lines 45-60) and the tags have coils (loop antennas) for us with the RF coupling means. (See Figure 1)

Regarding claim 12, Tanaka discloses an interactive tag (via IC card 24B) having stored profile information which can be operated on by profile data carried by another tag (via IC card 24A instructing IC card 24B to write purchase record data) with operating instructions (commands and sequences) when the tags are read in conjunction. (See Col. 5, lines 14-35 and Col. 4, lines 11-15)

But Tanaka fails to disclose the operating instructions are carried by a further tag.

Law teaches a system with a plurality of tags and a reader; Law discloses tags are very limited in memory due to severe cost constraints in a tag system. (See the Abstract, and Col. 1, lines 34-37)

From the teachings of Law, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system disclosed by Tanaka to

include a further tag to store the operating instructions separately, thereby allowing the ,

use of cheaper tags with a smaller memory in order to reduce costs.

13.   Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka in

view of Law et al. as applied to claims 8 and 7, and further in view of Hoemann (US

4,990,756).

Regarding claim 9, the combination of Tanaka and Law discloses the structural

elements of the claimed invention but fail to disclose some of the tags are passive and

that they are powered by way of the RF coupling means.

Hoemann teaches RFID systems comprised of passive tags without an

independent power source. When the tags are brought near a sensor, inductive

coupling occurs and the tags are powered by the RF carrier signal being emitted by the

sensor. (See Col. 2, lines 10-19)

From the teachings of Hoemann, it would have been obvious to one of ordinary

skill in the art at the time the invention was made to modify the combination of Tanaka

and Law to include passive tags as taught by Hoemann to use tags without a battery

source thereby reducing costs in using the system.

Conclusion

14.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Yong Hang Jiang whose telephone number is 571-270-

3024. The examiner can normally be reached on M-F 7:30 am to 5:30 pm alternate
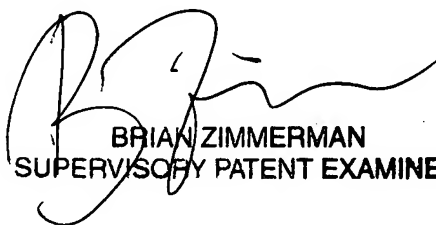
fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian A. Zimmerman can be reached on 571-272-3059. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

YHJ

BRIAN ZIMMERMAN
SUPERVISORY PATENT EXAMINER